

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 19 of invention is directed to non-statutory subject matter. It is directed towards a signal. Support can be found in Page 11 of the specification, where the media can include modulated data to encode information in a signal.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21, 22, and 23 recites the limitation "computer-readable media". There is insufficient antecedent basis for this limitation in the claim. The term "computer readable storage media" and "computer readable media" have different meanings based on the Page 11 of the specifications. It states that computer-readable media can be storage or signal medium.

Claims 2, 10, 12, and 23 are cancelled.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 5-9, 11, 13-17, 19-22 are rejected under 35 U.S.C. 102(e) as being unpatentable by Juan (US Pub 2004/0230708).

Consider Claim 1, Juan disclosed the apparatus comprising: first and second connectors, each of said connectors being adapted for connection to a computer (Abstract, Fig 3);

a communications router operatively situated between the first and second connectors for enabling communications between a target computer connected to the first

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connector and a source computer connected to the second connector (Fig 3, [0022]); a nonvolatile memory operatively situated between the first and second connectors and associated with the communications router ([0016]), said memory storing a driver for the communications router and a software load to be installed on the target computer to which the first connector is connected ([0023]), wherein said driver and said software load are installed on the target computer from the nonvolatile memory in response to connecting the first connector to the target computer ([0023]), wherein the software load comprises a user interface for guiding a user to transfer files from the source computer to the target computer and wherein the user interface comprises a migration utility for guiding the user to migrate files from source computer to the target computer via the communications router ([0023], Juan disclosed on how two computers are connected with a USB cable which contains drivers/software stored in the memory).

Claim 2 (canceled).

Consider Claim 3, Juan disclosed the apparatus of claim 1, wherein the software load comprises a setup program for installing the user interface ([0024]).

Consider Claim 5, Juan disclosed the apparatus of claim 1, wherein the connectors comprise universal serial bus (USB) connectors ([0023]).

Consider Claim 6, Juan disclosed the apparatus of claim 1, wherein the driver for the communications router causes the communications router to appear as a USB network connection to the target computer to which the first connector is connected ([0022]).

Consider Claim 7, Juan disclosed the apparatus of claim 1, wherein the nonvolatile memory appears as an auto run device to the target computer to which the first connector is connected ([0023]).

Claim 8, has similar limitations as Claim 1, therefore it is rejected under the same rationale as Claim 1.

Consider Claim 9, Juan disclosed the method of Claim 8, wherein initiating the autorun function includes permitting the nonvolatile memory to be detected as a new hardware device ([0021]).

Claim 10 (canceled).

Consider Claim 11, Juan disclosed the method of claim 8, wherein the setup software comprises an installer for installing the user interface ([0023]).

Claim 12 (canceled).

Consider Claim 13, Juan disclosed the method of claim 8, further comprising operatively situating the nonvolatile memory and the communications router between a pair of universal serial bus (USB) connectors, and wherein operatively connecting the nonvolatile memory and the communications router includes connecting the USB connectors to corresponding USB ports on the computers ([0022]-[0023]).

Claim 14, has similar limitations as Claim 6, therefore it is rejected under the same rational as Claim 6.

Consider Claim 15, Juan disclosed the method of claim 8, wherein initiating the autorun function comprises showing the nonvolatile memory as a CD-ROM device to the computers ([0016]).

Consider Claim 16, Juan disclosed the method of claim 8, further comprising communicating between the computers via the communications router ([0022]).

Consider Claim 17, Juan disclosed the method of claim 8, wherein initiating the autorun function and loading the driver is performed using plug and play technology ([0021]).

Consider Claim 19, Juan disclosed one or more computer-readable media have computer-executable instructions for performing the method of claim 8 ([0023]).

Claim 20, has similar limitations as Claim 1, therefore it is rejected under the same rational as Claim 1.

Claim 21, has similar limitations as Claim 6, therefore it is rejected under the same rational as Claim 6.

Consider Claim 22, Juan disclosed the computer-readable media of claim 20, wherein the setup program resides on a nonvolatile memory and further comprising autorun information for identifying the nonvolatile memory as a CD-ROM device for automatically launching the setup program ([0023]).

Claim 23 (canceled).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims **4, 18, 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Juan (US Pub 2004/0230708).

Consider Claim 4, Juan does not explicitly state the apparatus of claim 1, wherein the software load comprises a game.

But, it would have obvious to a person skilled in the art at the time of the invention to incorporate the use of a game, Juan disclosed the use of software load (drivers/applications), which is stored and run from the device during connection between computers.

Therefore it would have been obvious to a person skilled in the art at the time of the invention was made to incorporate the use of software game to the user, during file transfer process between computers.

Consider Claim 18, Juan does not explicitly state the method of claim 8, further comprising timing out after a predetermined period of time if a connection to only one of the computers is detected.

But it would be obvious to a ordinary person skilled in the art as Juan disclosed that the user will be informed by the operating system of the existence of a USB file transfer when the USB device is connected with the remote computer ([0018]-[0019]). Therefore, it would have been obvious to a person skilled in the art to see that if the USB device can't detect the remote computer when connected, it will not inform the user of its success, as the file transfer will not be automatically executed, thus timing out after unsuccessful attempts to find the remote computer.

Claim 24, has similar limitations as Claim 4, therefore it is rejected under the same rational as Claim 4.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH SIKRI whose telephone number is 5712701783. The examiner can normally be reached on 8am - 5pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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